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William James Harkin

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EXAMINER

STRODER, CARRIE A

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/563,188 | Applicant(s) HARKIN, WILLIAM JAMES | |
| | Examiner CARRIE A. STRODER | Art Unit 3689 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on 30 December 2005, wherein:

Claims 1-45 are currently pending; and
claim 46 is cancelled.

Claim Objections

1. Claim 19 is objected to because of the following informalities: claim 19 ends with a semi-colon rather than a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claim 11 is rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner has reviewed applicant's disclosure and submits that these added limitations find no support in the

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specification as currently written, and is, therefore, directed to new matter.

a. "periodic project plan" is not described in the specification as written. Examiner reviewed the specification and did not find that any mention of a periodic project plan.

3. **Claims 15-22 are rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 15 and 22 invoke 35 USC 112 when stating, "input means for" and "output means for". Claim 18 invokes 35 USC 112 when stating, "means for real time communication". However, the specification does not describe adequate structure for performing the recited function.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 5 is rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention.

Claim 5 states, "... wherein step a) is commenced *shortly* before steps b) and c)," which is vague and indefinite. The time period "shortly" may mean greatly varying amounts of time to different people.

6. **Claim 10 is rejected under 35 U.S.C. 112, second paragraph,** as lacking antecedent basis. Claim 10 recites the limitation "the ipr-commercialisation method". There is insufficient antecedent basis for this limitation in the claim. Examiner assumes applicant is referring to the method of claim 1.

7. **Claims 11 is rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 states "preparing *periodic* project plans," which is confusing. It is unclear how a periodic project plan is defined.

8. **Claims 15-21 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 states that it is a system which includes a "data storage means," a "data processing means," an "input means for..." and an "output means for..." A system claim is defined by structure. However, neither a "data storage means," nor a "data processing means," provide structure. As such, these claim limitations receive little patentable weight. However, in order to expedite prosecution, Examiner attempts to give weight to these limitations for purposes of the prior art rejections, below.

The claim limitations of claim 15 which are directed to an "input means for..." and an "output means for..." are interpreted in accordance with 35 USC 112, sixth paragraph, as providing structure. However, when Examiner turns to the specification, no structure is provided for these limitations. If there is no disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second paragraph. MPEP 2181.

Claim 17 states that it is a system which includes a a "data processing means," an "input means". A system claim is defined by structure. However, neither a "data processing means," nor "input means" provide structure. As such, these claim limitations receive little patentable weight. However, in order to expedite prosecution, Examiner attempts to give weight

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to these limitations for purposes of the prior art rejections, below.

Claim 19 states that it is a system which includes a "non-real time communication means". A system claim is defined by structure. However, a "non-real time communication means" does not provide structure. As such, this claim limitation receives little patentable weight. However, in order to expedite prosecution, Examiner attempts to give weight to these limitations for purposes of the prior art rejections, below.

Claim 20 states that it is a system which includes an "access regulation means". A system claim is defined by structure. However, an "access regulation means" does not provide structure. As such, this claim limitation receives little patentable weight. However, in order to expedite prosecution, Examiner attempts to give weight to these limitations for purposes of the prior art rejections, below.

9. **Regarding claims 18, 20, & 35** the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

10. **Regarding claims 18 and 44**, the phrases "or the like" and "and the like" render the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those

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encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

11. **Regarding claim 19**, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

12. **Claim 22 is rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 states that it is directed to a "tool". However, it is not clear what statutory class this "tool" falls into. It could be interpreted as an apparatus, a system, or even software per se. Since applicant is invoking 112, sixth paragraph in the later two claim limitations, Examiner interprets the claim as a system claim.

Claims 22 states that it is a "tool" which includes a "data storage means," a "data processing means," an "input means for..." and an "output means for..." An apparatus or system claim is defined by structure. However, neither a "data storage means," nor a "data processing means," provide structure. As such, these claim limitations receive little patentable weight.

However, in order to expedite prosecution, Examiner attempts to

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give weight to these limitations for purposes of the prior art rejections, below.

The claim limitations of claim 22 which are directed to an "input means for..." and an "output means for..." are interpreted in accordance with 35 USC 112, sixth paragraph, as providing structure. However, when Examiner turns to the specification, no structure is provided for these limitations. If there is no disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second paragraph. MPEP 2181.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 and 23-44 are rejected under 35 U.S.C. § 101

because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the "machine or-transformation test". In re Bilski, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the

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claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

With respect to claims 1-14, the claim language does not include the required tie to a particular machine or apparatus or transformation and thus is directed to nonstatutory subject matter.

Claims 23-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claims 15-20, the system contains software (data) structures not claimed as embodied in computer-readable media and therefore are descriptive material per se and are not statutory because they are not capable of causing function change in a computer.

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See In re Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760. Until it is expressed as a computer-readable "copy," e.g., on a CD-ROM, any software detached from an activating medium remains uncombinable. It cannot be inserted into a CD-ROM drive or downloaded from the Internet; it cannot be installed or executed on a computer. Abstract software code is an idea without physical embodiment. Microsoft v AT&T, 550 US 437, (2007).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-2, 6-10, and 12-13 are rejected under 35**

U.S.C. 102(e) as being anticipated by Salom (US 20030167175).

Referring to claim 1:

Salom discloses

a) identifying and protecting any intellectual property associated with the invention (paragraphs 23-24; "New ideas, products, tools, processes, systems, and services are developed

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within research and development group 180 and, when these have reached a sufficient level of development, they become new intellectual property which, is placed into intellectual property database..." and "...patent protection team...");

b) developing a prototype of a commercial product based on the invention (paragraph 24; "These entities may have marketable ideas and prototypes...");

c) identifying and/or developing potential markets for the product (paragraph 6; "...developing new products and market opportunities for at least one of the developed IP assets...");

d) determining a preferred route to market for the product (paragraph 29; "Select intellectual property from intellectual property database 135 is chosen...");

e) if the preferred route to market includes licensing the invention to a third party, then negotiating an appropriate license deal based on the results of steps a) to c), and terminating the method (paragraph 68; "...licensing of various intellectual property assets..." inherently includes negotiating an appropriate license deal);

f) if the preferred route to market includes creating a spin out company, developing a business plan for the spin out based on the outcomes of steps a) to c); recruiting a management team for the spin out, and identifying and

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approaching potential investors; engaging with selected investors; and launching the spin out company (paragraphs 28-30; "...matched with an appropriate business model, and leveraged ("spun out") into stand-alone companies..." and "Company-to-financial markets channel partners 175 are established financial institutions that provide financial capital and aid in bringing the spinout companies 145-155 to financial markets." and "Management team 160 provides the initial management expertise...").

Further, claim limitations 'e' and 'f' are optional, and as such, receive little patentable weight. See MPEP 2106.

Referring to claim 2:

Salom discloses wherein step a) further comprises the step of acquiring complementary intellectual properties associated with the invention (paragraph 24; "IP relationships 165 includes relationships and agreements with third-party creators of intellectual property that is added to intellectual property database 135." and "Holding company 140 develops agreements with IP relationships 165 wherein holding company 140 leverages intellectual property developed within IP relationships 165 for use by the spinout companies 145-155.").

Referring to claim 6:

Salom discloses further comprising the step of terminating the method in the event that any of the steps a) to f) do not provide satisfactory production or commercial results (paragraph 29; "Each product incubated in this way must meet the above criteria before being pushed into a stand-alone company.").

Referring to claim 7:

Salom discloses further comprising the step of revising any of the steps that do not appear to be performing satisfactorily (paragraph 62; "If the required risk/return profile is not met go back to step 510 and revise business plan model.").

Referring to claim 8:

Salom discloses wherein step a) includes the step of identifying possible future developments of the invention which may lead to further intellectual property (paragraphs 23-24; "New ideas, products, tools, processes, systems, and services are developed within research and development group 180 and, when these have reached a sufficient level of development, they become new intellectual property which, is placed into intellectual property database...").

Referring to claim 9:

Salom discloses wherein the development of a prototype or end user product includes the steps of designing a prototype or end user product, and production of a prototype or end user

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product (paragraph 24; wherein the possession of a prototype inherently includes designing it and producing it).

Referring to claim 10:

Salom discloses further comprising the step of appointing a human project manager to oversee the ipr-commercialisation method (paragraph 19; "Referring to FIG. 1, business model 100 includes a holding company 140, IP relationships 165, academic relationships 185, product-to-market channel partners 170 and company-to-financial market channel partners 175. Holding company 140 includes an IP asset engine 105, an intellectual property database 135, a management team 160...").

Referring to claim 12:

Salom discloses wherein the implementation of any or all of steps a) to f) of the method is modified throughout the period of implementation to take account of outcomes of any or all of the remaining steps of the method (paragraph 62; "If the required risk/return profile is not met go back to step 510 and revise business plan model.").

Referring to claim 13:

Salom discloses wherein certain of the steps or parts of steps of the method are performed by third parties (paragraph 48; "In this step, holding company 140 utilizes academic relationships 185 to develop and attract human resources,

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facilities and expertise and to generate value within business units 110-130 or spinout companies 145-155.").

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 15-17 and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Grainger et al. (US 20020059076).**

Referring to claim 15:

Grainger discloses

data storage means including data structures representing templates for documents for use in commercialization of intellectual property rights (paragraphs 90-100; "...storage system..." and "...patent application template...");

data processing means in communication with the data storage means, for retrieving and manipulating the data structures (paragraph 85; "client computer");

input means for inputting data and commands to the data processing means (paragraph 54; "user input device"); and

output means for outputting manipulated data structures from the data processing means (paragraph 85; where "client

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computer" is interpreted to include a monitor or display device).

Further, "for use in commercialization of intellectual property rights," and "for retrieving and manipulating the data structures" are directed to intended use and as such, receive little patentable weight.

Referring to claim 16:

Grainger discloses wherein the output means comprises a remote communications link to one or more further data processing means (paragraph 44; "...computers 103 and automated docketing server 108 are networked together via a private network 132. The private network 132 is coupled to the Internet 101, for example, via a router. The Internet 101 interconnects the private network 132 to a patent office 112 and to a smart filing server 107.").

Referring to claim 17:

Grainger discloses wherein a plurality of data processing means and input means are provided (paragraphs 44 & 54; "computers" and "User input device 230 may include a mouse, a trackball, a keyboard, a keypad, a touch pad, a joystick, a digitizing tablet, a wireless controller, a microphone, or other suitable input devices, or combinations thereof.").

Referring to claim 19:

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Grainger discloses non-real time communication means, such as email or webmail facilities (paragraph 66; "The mail server 324 provides functionality to send electronic mail...")

Referring to claim 20:

Grainger discloses access regulation means, for example, system privileges, password protection, or the like, to permit authorized users different levels of access to data structures for some or all of the duration of a project (paragraph 126; "Such access should be restricted (by way of passwords or otherwise) to only particular users.").

Referring to claim 21:

Grainger discloses wherein the data structures are selected from one or more of: project plans, invention disclosure forms, license agreements, business plans, contracts for outside suppliers, and the like (paragraph 92; "...an interactive smart disclosure form...").

Furthermore, the type of data is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention

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over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the type of data can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any

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functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 22:

Grainger discloses

data storage means including data structures representing templates for documents for use in management of a project (paragraphs 90-100; "...storage system..." and "...patent application template...");

data processing means in communication with the data storage means, for retrieving and manipulating the data structures (paragraph 85; "client computer");

input means for inputting data and commands to the data processing means (paragraph 54; "user input device"); and

output means for outputting manipulated data structures from the data processing means (paragraph 85; where "client computer" is interpreted to include a monitor or display device).

Further, "for use in management of a project," and "for retrieving and manipulating the data structures" are directed to intended use and as such, receive little patentable weight.

5. Claims 23-26, 30, and 32-45 are rejected under 35

U.S.C. 102(e) as being anticipated by Coyne (US 20030144970).

Referring to claims 23 & 36:

Coyne discloses

computer code for displaying and allowing user selection of a plurality of clients (paragraphs 60 & 91-92; "client data means" and where SQL databases inherently include queries which allow for selection of information);

computer code for displaying and allowing user selection of a plurality of projects associated with a selected client (paragraphs 60 & 96-98; "Project Means may be used to identify multiple projects that are being carried out in conjunction with the same client and/or matter." and where SQL databases inherently include queries which allow for selection of information);

computer code for displaying and allowing user selection of a plurality of activities associated with a selected project (paragraphs 60 & 99-101; "Event Means tracked by the present invention preferably include any one or more of various data about any significant event in conjunction with the project" and

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where SQL databases inherently include queries which allow for selection of information);

computer code for displaying and allowing user selection of a plurality of documents associated with a selected activity (paragraphs 60 & 106-107; "Documentation Means may be provided to enable access to documents relating to the Project through the common data format interface" and where the documents are associated to the activities (or events) through the project and where SQL databases inherently include queries which allow for selection of information); and

computer code for allowing user selection of a document, and display of a selected document (paragraphs 60 & 106-107; "Documentation Means may be provided to enable access to documents relating to the Project through the common data format interface").

Further, "allowing..." is not a positive recitation of a limitation, as it does not positively require the limitation to be performed.

Referring to claim 24:

Coyne discloses computer code for flagging particular documents to allow user selection of those documents only when certain other documents have been previously flagged (paragraph

109; "Once the milestone or event has been reached, the system preferably accesses the appropriate form.").

Referring to claim 25:

Coyne discloses wherein the computer program is provided in the form of a computer program product comprising computer code stored on a suitable data carrier (paragraph 91; "The data may be key entered into the accounting system and preferably transferred to the docketing system and other software applications" and where software is inherently stored on a suitable data carrier).

Referring to claim 26:

Coyne discloses wherein the computer program is provided in the form of computer code transmitted as data over an electromagnetic communications network (paragraph 124; "In a preferred embodiment, the system of the present invention is preferably implemented on Novell network, with database 400 running on a Lotus Notes server, cooperating with an SQL server 300 in communication with various servers, routers and network components on which the software applications are maintained...").

Referring to claim 30:

Coyne discloses
computer code defining participants in a particular activity (paragraph 58; "Alternatively, the method may further

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comprise: identifying a client associated with the data; identifying a matter associated with said client; identifying a project being undertaken on behalf of said client in conjunction with said matter..."), and

computer code for permitting a user to write messages to be communicated to any or all participants in that activity (paragraph 58; "Alternatively, the method may further comprise: identifying a client associated with the data; identifying a matter associated with said client; identifying a project being undertaken on behalf of said client in conjunction with said matter; identifying docketing information associated with the project; identifying budget information associated with the project; identifying expense information associated with the project; identifying an event relating to said project; storing said expense information and said docket information in one or more first proprietary formats; transferring said client, matter, budget, expense and docket information to a second common data format; and providing said client, matter, expense, and docket information to a user.").

Referring to claim 32:

Coyne discloses computer code for displaying the progress of the activities to a user (paragraph 58; "...providing said client, matter, expense, and docket information to a user").

Referring to claim 33:

Coyne discloses computer code for displaying information regarding any of the clients, projects, activities or documents (paragraph 58; "...providing said client, matter, expense, and docket information to a user").

Referring to claim 34:

Coyne discloses wherein the information is displayed simultaneously with display of the client, project, activity or document itself (Fig. A-46; where the client name is displayed with the routing information).

Referring to claim 35:

Coyne discloses wherein the information is displayed separately, for example in a separate subscreen from the client, project, activity or document itself (paragraph 126; "In an alternative preferred embodiment, as shown in FIG. 5, data means 100 is maintained in various data storage means 200 and application means 500: docketing data in a proprietary format such as CPI; accounting data in a proprietary format such as TMC; records in physical (paper) copies, email (ftp, ip, html, xml or other web enabled formats), and/or electronic image files (.tif, .pdf, .jpg and other formats), and related indices (document management systems such as DocsOpen); Address Books in a relationship management system (such as Notes Address Books,

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Rolodex, iEnterprise or other relationship management software); Word Processing and Work Product in word processing applications (Word and/or WordPerfect) and related indexing systems (such as DocsOpen or SoftSolutions); presentation tools (such as PowerPoint and Corel Presentations); and evaluation tools (such as Excel, Corel Quattro Pro, TreeAge decision tree software and other risk evaluation tools).").

Referring to claim 37:

Coyne discloses computer code for allowing user editing of a selected document (paragraph 126; "Word and/or WordPerfect" allow editing).

Further, "allowing..." is not a positive recitation of a limitation, as it does not positively require the limitation to be performed.

Referring to claim 38:

Coyne discloses computer code for allowing user communication with further users (paragraph 58; "Alternatively, the method may further comprise: identifying a client associated with the data; identifying a matter associated with said client; identifying a project being undertaken on behalf of said client in conjunction with said matter; identifying docketing information associated with the project; identifying budget information associated with the project; identifying expense

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information associated with the project; identifying an event relating to said project; storing said expense information and said docket information in one or more first proprietary formats; transferring said client, matter, budget, expense and docket information to a second common data format; and providing said client, matter, expense, and docket information to a user.").

Further, "allowing..." is not a positive recitation of a limitation, as it does not positively require the limitation to be performed.

Referring to claim 39:

Coyne discloses

computer code for allowing user definition of a plurality of activities to be administered (paragraphs 99-101; "Event Means tracked by the present invention preferably include any one or more of various data about any significant event in conjunction with the project");

computer code for allowing user definition of a plurality of documents associated with each defined activity (paragraphs 106-107; "Documentation Means may be provided to enable access to documents relating to the Project through the common data format interface"); and

computer code for allowing user selection of a document, and display of a selected document (paragraphs 60 & 106-107; "Documentation Means may be provided to enable access to documents relating to the Project through the common data format interface" and where the documents are associated to the activities (or events) through the project and where SQL databases inherently include queries which allow for selection of information).

Further, "allowing..." is not a positive recitation of a limitation, as it does not positively require the limitation to be performed.

Referring to claim 40:

Coyne discloses computer code for defining a default set of activities, and/or a default set of documents associated with a particular activity (paragraph 119; "FIGS. 14-16 illustrate sample flowcharts for a patent prosecution, counseling and advice, and litigation matters, respectively. The flowchart is preferably colored, illuminated, or provided with any other suitable indicator of the progress of the project. In preferred embodiments of the present invention these milestones may be keyed to certain event means achieved during the course of the project.").

Referring to claim 41:

Coyne discloses computer code for allowing user definition of a plurality of stages associated with each defined activity, and the sequence of the stages (paragraph 99; "An event may be recorded in the Docket, in physical records, or in an application specifically developed to support and record events.").

Further, "allowing..." is not a positive recitation of a limitation, as it does not positively require the limitation to be performed.

Referring to claim 42:

Coyne discloses computer code for allowing user definition of a plurality of projects, each of which comprises a number of activities (paragraphs 96-98 & 99-101; "Project Means may be used to identify multiple projects that are being carried out in conjunction with the same client and/or matter" and "Event Means tracked by the present invention preferably include any one or more of various data about any significant event in conjunction with the project").

Further, "allowing..." is not a positive recitation of a limitation, as it does not positively require the limitation to be performed.

Referring to claim 43:

Coyne discloses computer code for allowing user definition of a plurality of clients, each of which may comprise a number of projects (paragraphs 91-92 and 96-98; "Client Means preferably comprises data about the client for whom the project is being performed." and "Project Means may be used to identify multiple projects that are being carried out in conjunction with the same client and/or matter.").

Further, "allowing..." is not a positive recitation of a limitation, as it does not positively require the limitation to be performed.

Referring to claim 44:

Coyne discloses computer code for allowing user definition of a plurality of participants to be associated with activities, documents, and the like (paragraph 95; "Matter Means tracked by the present invention preferably includes any one or more of various data about the matter, including without limitation: Matter Name; Matter Number(s); Description; Matter Creation Data; Responsible Professional; Billing Contact(s) for that matter; any related documentation (including images); Powers of Attorney; pertinent contacts; and pertinent details about the matter.").

Further, "allowing..." is not a positive recitation of a limitation, as it does not positively require the limitation to be performed.

Referring to claim 45:

Coyne discloses a method of managing preset and bespoke projects efficiently within a collaborative environment that utilizes intranets and or the internet to convey data and messages (paragraphs 52 & 107; "As illustrated in the accompanying diagrams and described in the accompanying claims, the invention is a method and system for improving the accessibility and transferability of various data and/or information resources used in the management of a business and, in particular, a professional services practice." and "In a preferred embodiment of the present invention, Document Means further comprises an icon or link, in the Event Means or other field, to the document in a portable or application-independent format (such as an ODBC, relational databases; SQL, XML, HTML, tif, .jpg, or .pdf file); over the Internet, an extranet, or intranet").

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salom (US 20030167175).

Referring to claim 3:

Salom does not disclose wherein the steps are performed in parallel, but with staggered commencements.

Examiner takes Official Notice that it was well known at the time of the invention to perform steps in parallel, but with staggered commencements. When working on a large project, in order to get the project completed, although some steps must be started before others, many steps are often performed simultaneously. For example, when building a house, although hanging the drywall must be begun before painting may begin, it is not necessary for all the drywall to be hung before painting starts.

It would have been obvious to a person having ordinary skill in the art at the time of invention to modify the teachings of Salom as taught by Official Notice because this would decrease the time required for the invention to get to market.

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Referring to claim 4:

Salom does not disclose wherein steps a) to d) are commenced first, while steps e) to f) are commenced subsequently.

Examiner takes Official Notice that it was well known at the time of the invention to begin some steps prior to other steps. When working on a project, some steps must naturally be performed prior to other steps. For example, when filing a patent application, the invention must first be conceived, then refined, before an application can be filed.

It would have been obvious to a person having ordinary skill in the art at the time of invention to modify the teachings of Salom as taught by Official Notice because this provides a logical order in which to perform the method.

Referring to claim 5:

Salom does not disclose wherein step a) is commenced shortly before steps b) and c).

Examiner takes Official Notice that it was well known at the time of the invention to begin some steps prior to other steps. When working on a project, some steps must naturally be performed prior to other steps. For example, when filing a patent application, the invention must first be conceived, then

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the subsequent steps of refining the invention and filing the application may be commenced shortly thereafter.

It would have been obvious to a person having ordinary skill in the art at the time of invention to modify the teachings of Salom as taught by Official Notice because the sooner steps b and c commence, the sooner the invention may get to market.

Referring to claim 11:

Salom discloses further comprising the step of preparing periodic project plans (paragraphs 63-64; "developing operating and strategic plans")

Salom does not disclose preparing the project plans prior to commencing the remainder of the steps of the method.

It would have been an obvious matter of design choice to prepare the project plans prior to commencing the remainder of the steps of the method, since applicant has not disclosed that preparing the project plans prior to commencing the remainder of the steps of the method solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well by preparing the project plans prior to commencing the remainder of the steps of the method.

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3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Salom (US 20030167175), in view of Grainger et al. (US 20020059076).

Referring to claim 14:

Salom does not disclose; however, Grainger teaches providing a database containing templates of documents that may be needed to complete the steps (paragraph 7; The completed smart disclosure form may be converted to a patent application or defensive (or technical) publication by placing information from pre-selected fields in the invention disclosure form to pre-selected locations in the patent application, or defensive publication, template.").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Salom by using templates as taught by Grainger because this would facilitate completion of the method in both a faster and more accurate manner.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger et al. (US 20020059076), in view of Lee et al. (US 20030074354).

Referring to claim 18:

Grainger does not disclose; however, Lee teaches means for real time communication between data processing means; for

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example, videoconferencing, internet or intranet telephony, text-based messaging, or the like (paragraph 009; " In yet another embodiment, the invention is an apparatus for managing, storing, disseminating and sharing information on-line in real time using a network...").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Grainger by using real time communication as taught by Lee because this would facilitate the exchange of ideas.

5. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coyne (US 20030144970).

Referring to claim 27:

Coyne discloses wherein the code for displaying and allowing user selection of comprises code for displaying and allowing user selection of clients, projects, activities or documents hyperlinks, with brief details of each client, project, activity or document being displayed (paragraphs 60 & 96-98; "Project Means may be used to identify multiple projects that are being carried out in conjunction with the same client and/or matter." and where SQL databases inherently include queries which allow for selection of information).

Coyne does not disclose while the user selects a particular hyperlink to display the next client, project, activity or document in the hierarchy.

Examiner takes Official Notice that the use of hyperlinks to select items is old and well known. For example, when using an internet browser, a user clicks on a hyperlink to display information.

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Coyne by using hyperlinks as taught by Official Notice because this would allow the user to choose what should be displayed.

Referring to claim 28:

Coyne does not disclose a conventional hyperlink navigation tool.

Examiner takes Official Notice that the use of conventional hyperlink navigation tools (defined as an internet browser, according to applicant's specification) is old and well known. For example, Internet Explorer is Microsoft's internet browser.

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Coyne by using a conventional hyperlink navigation

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tool as taught by Official Notice because this would allow the user to display the information.

6. **Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coyne (US 20030144970), in view of Hansen, Michael Schacht and Dørup, Jens, "Wireless access to a pharmaceutical database: A demonstrator for data driven Wireless Application Protocol applications in medical information processing" J Med Internet Res. 2001 Jan-Mar; 3(1): e4 (hereinafter referred to as "Hansen").**

Referring to claim 29:

Coyne does not disclose; however, Hansen teaches a dedicated hyperlink navigation tool (Section I).

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Coyne by using a dedicated hyperlink navigation tool as taught by Hansen because this would allow the user to display the information on a portable device.

7. **Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coyne (US 20030144970), in view of Grainger et al. (US 20020059076).**

Referring to claim 31:

Coyne does not disclose; however, Grainger teaches computer code for retrieving document templates from a data store

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(paragraphs 90-100; "...storage system..." and "...patent application template...").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Coyne by retrieving document templates from a data store as taught by Grainger because this would allow the user to use the document template, enhancing accuracy and speed.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Heckman et al. (US 5875431);
- b. Donner (US 6154725);
- c. Risen et al. (US 6018714);
- d. Guheen et al. (US 6721713);
- e. Martin (US 6330547); and
- f. Harshaw (US 6542871).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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